



Atty. Dkt. No. 034536-0407

1/12/08 DAC \$
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tod R. SMEAL et al.
Title: GEF-H1B: BIOMARKERS, COMPLEXES ASSAYS
AND THERAPEUTIC USES THEREOF
Appl. No.: 10/611,671
Filing Date: 7/2/2003
Patent No.: 7,439,329 B2
Grant Date: October 21, 2008
Examiner: XIAOZHEN XIE
Art Unit: 1646
Confirmation Number: 5378

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 10/21/2008 as U.S. Patent No. 7,439,329 B2.

The Patent Office determined that the patent was entitled to 566 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to **785** days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

| | |
|---|----------|
| (a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): | 902 days |
| (b) Total Applicant delay: | 117 days |
| Final PTA Determination: | 785 days |


Applicants therefore respectfully request that the patent be accorded 785 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

By 

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Patent Term Adjustment Calculation System

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Docket Number: 034536-0407

Application Number: 10/611671

Patent Number: 7439329

| | Event Description | Event Date | Days from Filing | PTO Days | Applicant Days |
|-------------|--|------------|------------------|----------|----------------|
| Edit Delete | Application Filing Date | 07/02/2003 | 0 | | |
| | 14 month From Application date | 09/02/2004 | 428 | | |
| Edit Delete | Restriction Requirement | 06/27/2006 | 1,091 | 663 | |
| | 3 Year Period Starts | 07/02/2006 | 1,096 | | |
| Edit Delete | Restriction Requirement Response Received at PTO | 08/25/2006 | 1,150 | | |
| Edit Delete | Non-Final Office Action | 11/06/2006 | 1,223 | | |
| Edit Delete | Request For Continued Examination | 02/06/2007 | 1,315 | | |
| | 3 Year Period Stopped | 02/06/2007 | 1,315 | 219 | |
| Edit Delete | Non-Final Office Action | 05/01/2007 | 1,399 | | |
| | Non-Final Office Action + 3 months | 08/01/2007 | 1,491 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 09/04/2007 | 1,525 | | 34 |
| Edit Delete | IDS under 1.704(c)(8) filed at PTO | 11/26/2007 | 1,608 | | 83 |
| | Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo | 01/04/2008 | 1,647 | | |
| Edit Delete | Non-Final Office Action | 01/24/2008 | 1,667 | 20 | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 04/23/2008 | 1,757 | | |
| Edit Delete | Notice of Allowance | 08/01/2008 | 1,857 | | |
| Edit Delete | Issue Fee Paid | 09/11/2008 | 1,898 | | |
| Edit Delete | Patent Grant Date | 10/21/2008 | 1,938 | | |
| | | | Totals: | 902 | 117 |
| | | | PTA: | 785 | |

Created and maintained by

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